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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/788,953  | 02/26/2004  | Andre S. Chan        | HSJ920030262US1     | 6686             |
| 44425   | 7590        | 10/27/2006           | EXAMINER            |                  |
| THOMAS R. BERTHOLD<br>18938 CONGRESS JUNCTION COURT<br>SARATOGA, CA 95070 |             |                      | WATKO, JULIE ANNE   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2627                |                  |
| DATE MAILED: 10/27/2006   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/788,953

Applicant(s)

CHAN ET AL.

Examiner

Julie Anne Watko

Art Unit

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 20 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-5, 10 and 12.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: see attached.

10/25/2006 

Julie Anne Watko, J.D.  
Primary Examiner  
Art Unit: 2627

### ADVISORY ACTION

1. For purposes of appeal, Applicant's amendment will be entered, and the amended claims will be rejected on the grounds of the same art relied upon in the final rejection.

In the paragraph spanning pages 5 and 6, Applicant notes an apparent difference between the Examiner's interpretation and Applicant's interpretation of the finally rejected claims. The Examiner has approved Applicant's proposed amendment in order to eliminate any difference in claim interpretation, so as to simplify issues for appeal.

2. Applicant's arguments filed October 12, 2006, have been fully considered but they are not persuasive.

Butt et al explicitly teach "channels 204 concentrated in *one or more* portions of an inner surface of the base" (see col. 8, lines 20-21). Butt et al further teach "channels 204 concentrated in *one or more* portions of the inner surface of the base 180" (see col. 8, lines 60-64). It is clear that such "portions" are circumferentially spaced apart portions, insofar as Butt et al show that a "plurality of arcuate channels 158 are located upstream of the actuator arm 50" (see col. 7, lines 32-33), that "channels 158 are located downstream of the actuator arm 50" (see col. 7, lines 33-34), and that "channels 158 are located roughly midway between the upstream side of the actuator arm 50 and the downstream side of the actuator arm 50" (see col. 7, lines 35-37). The Examiner believes that these teachings together would fairly result in anticipation of the new limitation in independent claim 1.

However, even if these teachings together did not result in anticipation of independent claim 1, there would be no invention in relocating known parts, when the operation of the apparatus were not modified by the relocation. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70

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(CCPA 1950). See also In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). See also Potter Instrument Company, Inc. v. Bucode, Inc., 184 USPQ 662, 669 (E.D.N.Y. 1988) (a new or unexpected result can distinguish improvement from mere relocation of elements). Although some such obviousness rejections could be overcome by demonstrating unexpected results due to the claimed location of parts, Applicant has failed to demonstrate unexpected results due to the claimed location of parts.

On page 6, 1<sup>st</sup> full paragraph, Applicant argues that “the amendment is not a mere relocation of parts because the function of the Butt “surface features” is substantially different from the function of Applicants’ surface features. The function of the *continuous* channels of Butt is to encourage the turbulent flow caused by the actuator arm to become laminar. The function of the discrete radially *and circumferentially spaced-apart* surface features in Applicants’ invention is to reduce viscous shear forces *while maintaining existing laminar flow*.”

The Examiner has considered this argument thoroughly and asserts that Applicant has failed to demonstrate unexpected results. In fact, Applicant’s argument clearly demonstrates that the prior art result and the disclosed result are in fact the same result (i.e., laminar airflow).

The arguments above are similarly relevant to the obviousness rejection of independent claim 4, and to the rejections of the dependent claims.

3. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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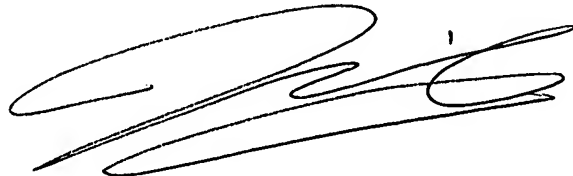
system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (571) 272-7597. The examiner can normally be reached on Monday through Friday, 1PM to 10PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Julie Anne Watko, J.D.  
Primary Examiner  
Art Unit 2627

October 25, 2006  
JAW

A handwritten signature in black ink, appearing to read 'Julie Anne Watko', with a stylized flourish at the end.